



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,722	03/24/2004	Alan Heddle Bremner		5327

7590 11/08/2004
GEOFFREY NEEDHAM
PLANTHAVEN, INC
PO BOX 3056
SANTA BARBARA, CA 93130-3056

EXAMINER
BELL, KENT L

ART UNIT 1661
PAPER NUMBER

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/806,722	Applicant(s) BREMNER, ALAN HEDDLE	
	Examiner Kent L. Bell	Art Unit 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

application filed 3/24/04

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

K. L. Bell

Detailed Action

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

Detailed Action

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

- A. Page 1, line 4, "GERANIUM" should be either italicized or underlined.
- B. Page 1, line 8, Applicant should place single quotation marks around "SABANI BLUE" as this is the proper way to designate a cultivar name.
- C. Page 1, lines 24 and 25, Applicant states the female parent is "A plant of the species". Applicant should set forth in the specification the name of the female parent plant, if named. If unnamed then applicant should simply state in the specification --An unnamed plant of the species--.

Detailed Action

D. Page 2, line 2, Applicant should delete “when” and insert --then--.

E. Page 2, line 6, Applicant states “When compared with the female parent, the species *Geranium libani*”. It appears applicant intends the female parent to be the entire species. However, applicant has previously stated the female parent was “A plant of the species” on page 1, lines 24 and 25. It appears applicant may have intended to state --, an unnamed plant of the species--, if accurate. Correction and/or clarification is necessary.

F. Page 2, line 8, Applicant states “When compared with the male parent, *Geranium ibericum ssp. Jubatum*”. It appears applicant intends the male parent to be the entire species. However, applicant has previously stated the male parent was pollen from bagged donor flowers take from plants of the species *Geranium ibericum ssp. Jubatum* on page 1, lines 26 and 27. It appears applicant may have intended to state --pollen from plants of *Geranium ibericum ssp. jubatum*--, if accurate. In addition it is not certain how one would know any comparison with a specific male parent since the pollen was mixed from various plants of the species unless the pollen was from one specific plant of the species. Correction and/or clarification is necessary.

Detailed Action

G. Page 2, lines 10-15, These lines are not understood as it is unclear whether applicant is comparing an entire species or a single plant of a particular species with the instant plant. Correction and/or clarification is necessary.

H. Page 4, lines 7 and 8, It appears applicant intends the female and male parents to be entire species. However, applicant has previously stated the female parent was "A plant of the species" on page 1, lines 24 and 25 and the male parent was pollen from bagged donor flowers take from plants of the species *Geranium ibericum ssp. Jubatum* on page 1, lines 26 and 27. It appears applicant may have intended to state --, an unnamed plant of the species--, if accurate, and --Pollen from plants of *Geranium ibericum ssp. jubatum*--, if accurate, respectively.

I. Page 5, line 1, Applicant states "Basal Leaves". It appears applicant may have intended to state --Basal stems--. Correction and/or clarification is necessary.

J. Applicant has described the instant plant's basal leaves but has not described the instant plant's regular leaves, if produced. Applicant should set forth in the specification the typical and observed leaf shape, length, width, apex, base, and margin descriptors and coloration (both surfaces) with reference to the employed color chart.

Detailed Action

K. Page 7, line 1, Applicant states “Petal arrangement: Unfused”. The recitation “Unfused” is not a petal arrangement. Correction and/or clarification is necessary.

L. Applicant should set forth in the specification additional information relative to the instant plant’s petal including the typical and observed petal apex descriptor.

M. Page 7, lines 12 and 13, Applicant states “green” and “red”. Applicant should set forth in the specification a color designation for the “green” and “red” colorations with reference to the employed color chart. The recitations “green” and “red” are vague and insufficient in these regards.

N. Page 7, line 25 and page 8, line 8, Applicant states “to match”. This recitation is not understood as it is unclear what applicant intends to match. Correction and/or clarification is necessary.

O. Applicant should set forth in the specification information relative to the instant plant’s Disease/Pest Resistance/Susceptibility.

Detailed Action

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (571) 272-0973. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached at (571) 272-0811.

The fax phone number for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

K. L. Bell

**KENT BELL
PRIMARY EXAMINER**

Kent L. Bell